II. REMARKS

Claims 68 to 103 are pending in the subject application. Claims 68 to 85 and 94 to 103 are withdrawn from consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a non-elected group or species. Claim 86 has been amended in a sincere effort to place the claims in condition for allowance. Support for the amendment to the claim is found on page 4, line 24 of the specification. Thus, an issue of new matter is not raised by these amendments and entry thereof is respectfully requested.

Amended claims 86 to 93 are currently under consideration.

In view of the remarks that follow, reconsideration and withdrawal of the rejections of the claims is respectfully requested.

35 U.S.C. § 103

Claims 86 to 93 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Herrick, U.S. Patent No. 4,781,187. The Office admitted that the patent teaches employment of donor corneal tissue (inherently comprising natural polymers such as collagen and mucopolysaccharide) as the implant material (column 3, lines 41-49). The Office argued that substituting a synthetic polymer material would have been obvious in order to provide greater control over material properties, to reduce risk of disease transmission, to ensure availability of materials, and so on, especially in the absence of any advantage or criticality in the instant disclosure of synthetic polymers over natural polymers. The Office noted that the Applicants' specification states that synthetic or natural polymers may be used (page 1, lines 18-19; page 17, lines 15-17) and even includes collagen as a possible material (original claim 63). The Office also argued that synthetic polymers were well known in the art, as evidenced by the Applicant's statements at page 2, line 24 *et seq.* of the specification and by prior art references of record. With respect to claims 88 and 89, the Office opined that a radius of curvature within the prescribed ranges would have been immediately obvious from the intended use of the device, as best illustrated by Figures 3, 4, 7, and 9. With respect to claims 91-93, the Office stated that although Herrick specifies typical dimensions "on the order of a length of 3.5 to 4.0 millimeters"

(column 3, lines 52-56), lengths as low as 2.0 millimeters would have been obvious in order to accommodate experimentation or practice on rabbits and other small animals or to minimize the length of the corneal incision.

Claims 86-93 also stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Gonchar et al., "Interlayer Refraction Tunnel Keratoplasty in Correcting Myopia and Astigmatism". The Office argued that implants being of a synthetic polymer would have been an obvious material variant for reasons provided above with respect to the Herrick patent. Regarding claims 88 and 89, the Office stated that values within the specified ranges would have been immediately obvious from the purpose of the implants (Figure 3). Regarding claim 93, the Office argued that an implant having a length of 2.0 mm or less would have been obvious in order to accommodate a variety of eye sizes (*e.g.*, page 2, lines 3-4, of said translation) and refractive disorders.

The Office also stated that Applicants' prior remarks were considered but were not considered persuasive because they were unsupported. Attached to this reply is a Declaration of joint inventor Thomas A. Silvestrini that supports Applicants' prior remarks. In view of the filing of the attached declaration and statements made therein, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

35 U.S.C. § 102

Claims 88, 89 and 91-93 are newly rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Civerchia, U.S. Patent No. 5,213,720. The Office noted that 86 MPEP 2106, section II. C., explains that language which suggests or makes optional but "does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation"; "examples of language that may raise a question as to the limiting effect of the language in a claim" are "adapted to" and "adapted for" clauses. The Office argued that therefore, the embodiments shown in Figures 14 and 17 can be inserted into the cornea (Figure 4; column 6, lines 20-21; column 18, lines 9-12) and thus possess a radius of curvature along a centroidal axis of at least 5.0 mm; because of their elongate form, these embodiments clearly extend in a meridional

direction. Regarding claims 88 and 89, the Office argued that the particular radius of curvature would have been immediately obvious from the anatomy depicted in Figure 4. With respect to claims 91-93, the Office argued that the length of the tabs **132** being less than or equal to 2.0 mm would have been obvious from the drawing (Figure 17) and would have been obvious in order to lessen the trauma to the cornea.

Applicants respectfully traverse for the reasons of record. Civerchia discloses a contact lens that sits on top of the cornea. In contrast, Applicants claim an insert, not a lens as disclosed in the cited art. Claim 86 has been amended herein to more clearly point out and distinctly claim Applicants' invention. In view of the preceding amendment and remarks, reconsideration and withdrawal of the rejection is respectfully requested.

III. CONCLUSION

If a telephone interview would advance prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below. In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account**

No. 50-2518 referencing billing reference 7004234002. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Date: April 5, 2005

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